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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,502	04/15/2004	Shozo Kobayashi	2026-0104006Reg	6567

22850 7590 08/23/2007

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EXAMINER	
PATTERSON, MARC A	
ART UNIT	**PAPER NUMBER**
1772	

NOTIFICATION DATE	DELIVERY MODE
08/23/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/824,502	KOBAYASHI ET AL.	
	Examiner	Art Unit	
	Marc A. Patterson	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 June 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5,7,8,10-12 and 16-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5,7,8,10-12 and 16-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/24/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 21 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 21 is directed to a method of using a tube – shaped sleeve, rather than to a tube – shaped elastic sleeve.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 21 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

NEW REJECTIONS

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase 'an inner surface of the internal semiconductive layer' is indefinite as it is unclear what surface is being referred to. The phrase 'define an inner surface of the sleeve' is unclear as it is unclear if the phrase means that the semiconductive layer, insulation layer and stress – relief cones define different surfaces or, together, a single surface; if the phrase refers to a single surface, it is unclear what the surface is. The phrase 'a region including the inner surface of the internal semiconductive layer' is indefinite as it is unclear exactly what the region is.

Claim 5 recites the limitation "both sides" in line 8. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term 'corn' is indefinite, and appears to be a typographical error.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 5, 7 – 8, 10 – 12 and 16 – 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bottcher et al (U.S. Patent No. 4,390,745).

With regard to Claims 5 and 7, Bottcher et al disclose a sleeve that is tube shaped (tube, therefore a cylinder; column 9, lines 39 – 43) that is cold – shrinkable (elastic stresses urge the tube to recover into conformity with a substrate; the tube is therefore elastically recoverable; column 5, lines 63 – 68) comprising a polymer that is elastic (elastomer; column 5, line 57), comprising an internal semiconductive layer (layer '9,' which is semiconductive, and which is an internal layer as shown in Figure 2; column 10, lines 17 – 20) and which includes a semiconductive material (carbon black; column 3, lines 40 – 43) and an insulation layer that is

formed around the internal semiconductive layer (insulating layer; column 5, lines 43 – 46) and is molded (column 11, lines 27 – 33) and which is reinforced (comprising additives to achieve good discharge resistance; column 5, lines 43 – 46); the sleeve has two stress – relief cones, wherein one stress relief cone is formed at each end of the sleeve (each cable shield end; column 6, lines 49 – 56); Bottcher et al also disclose additional layers outside of the layers of the sleeve (column 3, lines 13 – 27); Bottcher et al therefore disclose the addition of two sleeves to the outside of the sleeve, each of which is identical to the sleeve; Bottcher et al therefore discloses an external semiconductive layer, the semiconductive layer of the outermost sleeve, that includes an elastic material and a semiconductive material, and is formed around the reinforced insulation layer, and is insulated from both the stress – relief cones by the other insulation layer of the other additional sleeve; because Bottcher et al disclose an external semiconductive layer that is molded, Bottcher et al disclose an external semiconductive layer that is molded around the reinforced insulation layer; however, the claimed aspect of the semiconductive layer being molded around the reinforced layer is given little patentable weight; Bottcher also discloses edge – cut sections near each of the stress – relief cones (sections 'x' and 'y' in Figure 2, in which the semiconducting layers are cut off from each other); the claimed aspect of the sections being formed by cutting, however, is directed to a process limitation and is therefore given little patentable weight; as shown in Figure 7, the ends of the stress relief cones are uncovered by the reinforced insulation layer; an external end portion, with respect to the internal semiconductive layer, of an outer periphery of each stress – relief cone is therefore uncovered by the reinforced insulation layer.

With regard to Claim 8, Bottcher et al do not disclose non – uniformities in thickness; Bottcher et al therefore disclose an external semiconductive layer having a substantially uniform thickness.

With regard to Claim 10 – 11 and 16, as stated above, Bottcher et al disclose additional layers inside of the layers of the sleeve (column 3, lines 28 – 35) and therefore disclose a sleeve that is supported on a disassemble carrier in an expanded state and edge – cut sections that are free of the external semiconductive layer to expose a part of the reinforced insulation layer at each end of the reinforced insulation layer and a reinforced insulation layer that is uncovered by the external semiconductive layer to be exposed.

With regard to Claim 12, the Bottcher et al disclose elastic material comprising ethylene – propylene rubber (column 4, lines 1 – 2).

With regard to Claims 17 and 20, as shown in Figure 7, Bottcher et al also disclose two external insulation portions that are free of the external semiconductive layer.

With regard to Claim 18, because Bottcher et al disclose additional layers, Bottcher et al disclose an external semiconductive layer that is absent in a region in a direction of a length of the sleeve between the end of the sleeve and a point on an inner periphery of the sleeve at which the reinforced insulation layer and the stress – relief cone contacts.

With regard to Claim 19, Bottcher et al do not disclose a change in inner diameter, outer diameter or thickness; a constant inner diameter, outer diameter and thickness are therefore disclosed by Bottcher et al.

ANSWERS TO APPLICANT'S ARGUMENTS

7. Applicant's arguments regarding the 35 U.S.C. 102(b) rejection of Claims 5 – 8 as being anticipated by Bottcher et al (U.S. Patent No. 4,390,745), of record in the previous Action, have been carefully considered but have not been found to be persuasive for the reasons set forth below.

Applicant argues, on page 11 of the remarks dated June 4, 2007 that Bottcher et al do not disclose an external semiconductive layer extending only in a central portion of a length of the sleeve.

However, an external semiconductive layer extending only in a central portion of a length of the sleeve is not claimed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc A Patterson whose telephone number is 571-272-1497. The examiner can normally be reached on Mon - Fri 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marc Patterson 8/20/07
Marc A. Patterson, PhD.
Primary Examiner
Art Unit 1772